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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/088,174	06/19/2002	Ducroix Bertrand	P07566USOO/BAS	8862
881	7590	07/01/2004	EXAMINER	
STITES & HARBISON PLLC 1199 NORTH FAIRFAX STREET SUITE 900 ALEXANDRIA, VA 22314			EGWIM, KELECHI CHIDI	
			ART UNIT	PAPER NUMBER
			1713	

DATE MAILED: 07/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.	Applicant(s)	
	10/088,174	BERTRAND ET AL.	
	Examiner	Art Unit	
	Dr. Kelechi C. Egwim	1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05/13/2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-15 and 17-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-15 and 17-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of species (b), claims 11-15 and 17-20 in the reply filed on 05/07/2004 is acknowledged.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 11-15 and 18-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, **to make** and/or use the invention.

These claims attempt to define the subject matter in terms of the result to achieved, by referring to a combination of two properties of the material that is claimed or used in the said claims (cf. "said material having a tensile strength of between 6 and 20 MPa and an elongation at break of between 50% and 300%"), which merely amounts to stating the problem to be solved by the invention. The technical features required to achieve that result and to solve the problem must be added, because it would doubtless not be possible to make a composition satisfying the requirements

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defined in the claims, by randomly selecting **any** practically non-reticulated olefin polymer thermoplastic. The description is not sufficient to enable one of ordinary skill in the art to prepare the material consistent with the limitations of these claims, without undue experimentation. The scope of the claims must be consistent with the scope of the invention enabled in the description.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 20 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. The claim recites that "said ethylene copolymer has a monomer content not exceeding 30%", which is unclear and indefinite. How can a polymer only contain 30% of total monomer units? What makes up the rest of the polymer?

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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8. Claims 11, 13-15 and 18-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Breant (USPN 5,166,250), Skipper (GB 2110696), Bartholomeus et al. (EP 54424) or Anzini et al. (EP 204453).

In col. 2, lines 23-61 and col. 5, lines 14-21, Breant teaches an extrudable material including a thermoplastic polymer phase containing at least one of the present olefin polymers, 120 to 240 parts (about 55 to 71 weight % of the composition) of a content filler such as calcium carbonate, said material having a tensile strength of at least 10 MPa and an amount of extension at breakage of at least 110%.

In Tables 1 and 2, Skipper teaches an extrudable material including: a thermoplastic polymer phase containing at least one of the present olefin polymers, 100 parts (50% of the composition) of a content filler, said material having a tensile strength around 11 or 12 MPa and an amount of extension at breakage from 102 to 230%.

In page 2, line 15 to page 3, line 6 and the Examples, Bartholomeus et al. teach an extrudable material including a thermoplastic polymer phase containing at least one of the present olefin polymers, 150 to 260 parts of a content filler, based on 100 parts of polymer, said material having tensile strengths from approximately 5 to 9 N/mm² (MPa) and an amount of extension at breakage from 140 to 200%.

In Examples 5 and 11, Anzini et al. teach an extrudable material including a thermoplastic polymer phase containing at least one of the present olefin polymers, 200 parts of a content filler, based on 150 parts of polymer (about 57% of the composition), said material having tensile strengths from 950 to 1029 psi (6.55 to 7 MPa) and an amount of extension at breakage from 150 to 196%.

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Thus, the requirements for rejection are fully met.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 11-15 and 17-20 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, 35 U.S.C. 103(a) as being unpatentable over Himes et al. (USPN 4,216,131).

In col. 1, lines 38-58, col. 3, lines 45-48 and col. 4, lines 7-10, Himes et al. teach an extrudable material comprising:

10 to 50 parts by weight of polyethylene having specific gravity below 0.94 with a melt flow index of 0.4 to 5 g/10 min;

5 to 100 parts EVA copolymer containing 9 to 29% vinyl acetate; and

up to 250 parts, based on 100 parts of the polymer component, of a filler, preferably calcium carbonate.

While Himes et al. does not report property data such as tensile strength, extension at breakage and "Shore D Hardness" as claimed, it is reasonable that the thermoplastic material of Himes et al. would possess the presently claimed properties since the compositional limitation of the present composition fall well within the composition defined in Himes et al. and the two materials are essentially the same as

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the claimed composition. In any event, an otherwise old composition is not patentable regardless of any new or unexpected properties. In re Fitzgerald et al , 619 F.2d 67, 205 USPQ 594 (CCPA 1980). See MPEP § 2112 - § 2112.02.

Even if assuming that the prior art references do not meet the requirements of 35 U.S.C. 102, it would still have been obvious to one of ordinary skill in the art, at the time the invention was made, to arrive at the same inventive composition because the disclosure of the inventive subject matter appears within the generic disclosure of the prior art.

11. Claim 12 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, 35 U.S.C. 103(a) as being unpatentable over Breant, Skipper, Bartholomeus et al. or Anzini et al.

While Breant, Skipper, Bartholomeus et al. or Anzini et al., do not report data with regard to "Shore D Hardness" as claimed, it is reasonable that the thermoplastic materials of Breant, Skipper, Bartholomeus et al. or Anzini et al. would possess the presently claimed property since the prior art thermoplastic materials are essentially the same as the claimed composition and the USPTO does not have at its disposal the tools or facilities deemed necessary to make physical determinations of the sort. In any event, an otherwise old composition is not patentable regardless of any new or unexpected properties. In re Fitzgerald et al , 619 F.2d 67, 205 USPQ 594 (CCPA 1980). See MPEP § 2112 - § 2112.02.

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Even if assuming that the prior art references do not meet the requirements of 35 U.S.C. 102, it would still have been obvious to one of ordinary skill in the art, at the time the invention was made, to arrive at the same inventive composition because the disclosure of the inventive subject matter appears within the generic disclosure of the prior art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Kelechi C. Egwim whose telephone number is (571) 272-1099. The examiner can normally be reached on M-T (7:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KELECHI C. EGWIM PH.D.
PRIMARY EXAMINER

KCE

